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In re Application of ETORI et al
Serial No. 09/740,809
Filing Date: December 12, 2000
For: A SEE-THROUGH LIGHT
TRANSMITTING TYPE SCREEN

JAN 7 2003
DECISION ON PETITION
UNDER 37 CFR 1.181
FOR WITHDRAWAL OF THE FINALITY OF THE
ACTION OF October 25, 2002

This is a decision on the petition under 37 CFR 1.181 for withdrawal of the finality of the action of October 25, 2002. Petitioners alleges that the final action was premature because their response of August 16, 2002 amended claim 1 to include the limitations of cancelled claim 3 and claim 2 and adding the word "laminated". Petitioner states that if the original claim 3 was not anticipated by Wantanabe et al, then it necessarily follows that claim 1 as amended on August 16, 2002 to include the limitation of claim 3 would not be anticipated by Watanabe et al. Applicant concludes that since Wantanabe et al was not applied under an anticipation rejection to the subject matter of claim 3, the rejection of the amended claim 3 was premature.

A review of the first office action mailed March 18, 2002 shows that claim 2 was rejected under 35 USC 102 as anticipated by Watanabe et al (6,262,840) and that claim 3 was rejected under 35 USC 103 as obvious over the same Watanabe et al reference in view of Lee.

MPEP 706.07(a) states "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." The same section of the MPEP also states "A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed."

As petitioners pointed out, claim 1 was amended not only by adding the structure of dependent claims 2 and 3, but also introducing the new limitation that the two layers were laminated. Thus the subject matter of laminating the two layers found in amended claim 1 was not previously before the examiner. Furthermore, Watanabe et al was of record and was applied, either under 102 or 103, to all the claims in question. Further, claim 3 depended on claim 1 and did not depend on claim 2. Therefore, the combination of claims 2 & 3 also constituted subject matter not previously before the Examiner. Consequently, the Examiner could have entered a new grounds of rejection of claim 1 and still properly made the rejection final.

In view of the above, the action mailed October 25, 2002 was properly made final under MPEP 706.07(a).

The petition is **DENIED**.

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